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09/709,581	11/13/2000	Ernesto Marelli	33885/GM/lp	5196

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 11/20/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 8-12-02

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above claim(s) 14-17 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-13 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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### DETAILED ACTION

This Office action is in response to the amendment filed August 12, 2002 in which claims 1, 3, 4 and 11-13 were amended and claims 14-17 were added. It should be noted that claim 4 contains subject matter that has not been identified in the marked-up copy.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendments to the claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13, 15 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original filed specification does not support a liquid fuel that is rapeseed oil or sunflower oil. At page 8 lines 1-6, Applicant discloses methyl esters of rapeseed and sunflower oil.

Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim, either directly or indirectly. See MPEP § 608.01(n).

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1. Newly submitted claims 14-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: There is no mention in the previously filed fuel claims or method claims of premixing the components and subjecting them to a series of successive steps of flow velocities. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lepain (US 4,477,258) or Boehmke (US 4,295,859) or Nixon (US 3,615,290).

Lepain teaches a diesel fuel composition comprising 97-90 vol% of a mixture of a major amount of diesel fuel and a minor amount of least 5 volume % ethanol and/or methanol. The composition is an emulsion and contains 3-10 vol % of an emulsifying blend of sorbitan monooleate and an ethoxylated surfactant (see abstract; col. 1, lines 45-52). The ethoxylated surfactant may be ethoxylated nonylphenol with 8-50 EO or

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ethoxylated fatty alcohols with 6-50 EO (see col. 2, lines 50-58; Example 1(D)). The volume percent of water is from 43 to 74 percent of the aqueous alcohol solution (see col. 1, lines 53-56). This encompasses the water proportions. Lepain teaches that the required HLB may be reached by varying the amounts of the emulsifiers.

Boehmke teaches a gasoline or diesel fuel composition that contains 55-97% fuel; 0.5-40% water and emulsifiers (see abstract; col. 1, lines 5-12). The non-ionic emulsifiers (emulsive) are oxyethylated products (2-5 mols) of alcohol with 8-22 C atoms, such as cetyl stearyl alcohol or nonyl phenol + 6 mols of ethylene oxide (see Examples 9 and 10). Emulsifiers such as fatty acid monoglycerides are also present in the composition (see col. 3, lines 1-13).

Nixon teaches a diesel fuel composition comprising about 1.5 wt% water, 0.001 to 1 wt% corrosion inhibitor (salt of PIBSA) and 0.25-10% emulsifier (see abstract; col. 3, lines 7-20; col. 4, lines 24-36 and claim 1). Nixon teaches that a combination of two or more emulsifiers obtains the best results. The HLB of the emulsifiers is from 11-16 and the emulsifiers include C<sub>5</sub>-C<sub>12</sub> alkylphenylpolyethoxy alcohols (5-15 ethoxy groups), ethoxylated fatty alcohols and sorbitan monooleate (see col. 5, lines 35-75; col. 6, lines 1-33).

Lepain, Boehmke and Nixon teach the limitations of the claims other than that the fuels are prepared by the claimed method. However, "the Patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." See MPEP 2113.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6 and 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Haupais (US 6,068,670).

Haupais teaches an emulsified diesel fuel composition comprising at least 5% water, sorbitan monooleate, nonylphenol ethyoxylate and optionally at least one esterified or non-esterified vegetable oil (see abstract; col. 6, lines 18-45; col. 7, lines 10-25; col. 7, lines 46-57; col. 8, lines 56-64). Haupais outlines the proportions of the components as follows: hydrocarbon fuel 50-99%; vegetable oil or ester thereof 1-60%; emulsifying system 0.5-5%, and additives (biocide) 0.01-5% (see col. 8, lines 32-53). These proportions anticipate those of the present invention.

Accordingly, Haupais teaching all the material limitations of the claims anticipates the claims.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haupais further in view of Boehmke (4,295,859).

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Haupais has been discussed above. Haupais fails to teach that the emulsive is C<sub>16</sub>-C<sub>18</sub> cetyl stearyl alcohol. However, Boehmke teaches this difference (see col. 1, lines 64-58; col. 2, lines 1-7; Example 10).

It would have been obvious to one of ordinary skill in the art to have replaced the nonylphenol ethoxylate of Haupais with the cetyl stearyl alcohol because Boehmke teaches that the emulsive agents are art recognized equivalents.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haupais further in view of Nixon (3,615,290).

Haupais has been discussed above. Haupais fails to teach that the composition of his invention contains products of polyisobutenyl succinic anhydride. However, Nixon teaches this difference (see col. 3, lines 7-20).

It would have been obvious to one of ordinary skill in the art to have included a product based on polyisobutenyl succinic anhydride because Nixon teaches that these products enhance fuel emulsion characteristics by minimizing or eliminating the corrosion problems associated with water containing fuels.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714